

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-19 are currently pending in the present application. Claims 1, 4, 7, 12, and 18 are currently amended without introducing any new matter.

In the pending Office Action, the title of the invention was objected to as not being descriptive, and the abstract of the disclosure was objected to as not being on a separate sheet. Claims 1-2, 4, 16-19 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Coverdale et al.* (U.S. Patent No. 6,373,842, hereinafter "*Coverdale*"). Claim 12 was rejected under 35 U.S.C. § 102(b) as being anticipated by *Minoda* (Japanese Patent No. JP 07-037341). Claims 3 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Coverdale* in view of *Carlson et al.* (U.S. Patent No. 6,804,496, hereinafter "*Carlson*"). Claim 5, 7-8, and 10-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Coverdale* in view of *Minoda*. Claims 13-14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Minoda* in further view of Official Notice.

In response to the objection of the title of the invention, the title of the invention is amended to be more descriptive to recite "Recording Apparatus and Recording Method for Detecting Errors in Recording Data." In response to the objection to the abstract of the disclosure, the abstract is amended and provided on a separate sheet, as required by the pending Office Action. No new matter has been added.

Claim 1 is amended to recite "and for controlling said reproducing means to stop reproduction of other units of data not at said start position when said detection means detects the error signal," and to correct a minor formality. These amended features find non-limiting support in Applicants' specification

as originally filed, for at least from p. 20, l. 27, to p. 21, l. 4.

Turning now to the rejection of Claim 1 under 35 U.S.C. § 102(e) over Coverdale, Applicants respectfully traverse the rejection, and request reconsideration thereof, as next discussed.

Applicants' Claim 1 is directed to a recording apparatus that records main data divided into a plurality of units of data reproduced by a reproducing apparatus and sent through a network. The recording apparatus includes, *inter alia*: recording means for recording a main data sent from said reproducing apparatus; communication means for communicating with said reproducing apparatus; detection means for detecting a communication error of said main data; notification means for notifying said reproducing apparatus of an occurrence of said communication error; and control means for controlling said recording apparatus **to permit the recording again from a start position where recording of the main data started when the communication error is detected** by said detection means and for controlling the communication means **to send a stop signal to the reproducing apparatus through the network to stop reproduction of other units of data.**

Turning now to the applied references, Coverdale describes a streaming service system to deliver speech frames from a voice mail server 110 over a network 120 to a wireless terminal 140. (Coverdale, col. 5, ll. 31-34, Fig. 2, Abstract.) Coverdale explains that after an error in frame 142 is detected and a transmit request is sent by the terminal 140, "speech frames 123 and 124 from speech transmission buffer locations 113 and 114 are sent and transmitted over the radio interface." (Coverdale, col. 5, ll. 51-60.) This means that after a frame is transmitted and received having an error, the server 110 sends out further speech frames. Coverdale also explains that

the speech buffer 200 is filled with frames 211-215, and an erroneous frame is replaced, before delivery of the speech frames begins for playing back the speech. (Coverdale, at col. 6, ll. 6-19.)

However, Applicants' Claim 1 clearly recites that the communication means sends a stop signal to the reproducing apparatus to stop reproduction of other units of data. Coverdale, however, needs to fill the buffer first. Because Coverdale is directed to streaming transmission of data, it cannot "send a stop signal to the reproducing apparatus through the network to stop reproduction of other units of data," as required by Applicants' Claim 1.

In addition, Coverdale also fails to teach that the recording apparatus is controlled to permit the recording again from a start position where recording of the main data started when said communication error is detected, as further required by Claim 1. First, Coverdale does not record data, but stores data units in a temporary buffer. (Coverdale, col. 5, l. 66, to col. 6, ll. 4.) Second, Coverdale fails to permit recording again from a start position where the recording of the main data started when said communication error is detected, as of Applicants' Claim 1. Coverdale continues to communicate to fill buffer 200 when an error in a frame 142 is detected, and merely replaces a frame 142. Coverdale does not record again from a "start position where recording of the main data started when said communication error is detected." (Coverdale, col. 5, ll. 51-65). Accordingly, Coverdale fails to teach all the features of Applicants' Claim 1.

The reference *Minoda*, relied upon by the pending Office Action to form 35 U.S.C. § 103(a) rejections, also fails to remedy the deficiencies of Coverdale, as next discussed.

*Minoda* is directed to a recording apparatus to record compressed data of a MiniDisk (MD) recording system, where

errors in reproduction can be detected. (*Minoda*, Abstract, and Claim 1.) However, in *Minoda*'s apparatus, when a reproduction error occurs, the apparatus "resumes reproduction at sub-code frame two units prior to the error generating location." (*Minoda*, Abstract, ¶ 37.) However, Applicants' Claim 1 recites:

control means for controlling said recording apparatus to permit the recording again from a start position where recording of the main data started when said communication error is detected by said detection means

Claim 1, portions omitted. Accordingly, *Minoda*, just like *Coverdale*, does also not record again from a "start position where recording of the main data started when said communication error is detected," as recited in Claim 1. Therefore, even if we assume that the combination of *Coverdale* and *Minoda* is proper, the combination fails to teach all the features of Applicants' independent Claim 1,

Applicants also respectfully traverse the obviousness rejection based on *Coverdale* and *Minoda* because there is insufficient evidence for a motivation to modify *Coverdale*'s streaming for producing audio speech for a mobile terminal (*Coverdale*, Abstract) by incorporating *Minoda*'s error detecting system when recording compressed MiniDisk data delivered from a CD, for the following reasons.<sup>1</sup>

The outstanding Office Action asserts that the proposed modification would have been obvious and states "[o]ne

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<sup>1</sup> See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

ordinary skill in the art at [sic] would have been motivated to do so to perform dubbing without data break even if errors should occur during dubbing to enhance the reproduction quality."<sup>2</sup> The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification.

For example, is not clear from the record how *Minoda's* suspension of the production of sub-code could be incorporated into *Coverdale's* data streaming device. Under such a modification, the data streaming of *Coverdale* would be interrupted, and *Coverdale* clearly teaches away from such a goal. To the contrary, *Coverdale* even timely reconstructs corrupted frames before delivery, if the corrupted frame cannot be retransmitted. *Coverdale* thereby assures constant delivery rate of data for voice messages, so that the data streaming is not interrupted. (*Coverdale*, Abstract, ll. 12-16, col. 6, ll. 19-28). Accordingly, the alleged desirable modification of *Coverdale* would not only require a substantial reconstruction or redesign, but would also change the basic principle of operation of *Coverdale*. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.<sup>3</sup>

*Coverdale* and *Minoda*, therefore, do not provide the motivation to perform the proposed modification of *Coverdale*. In other words, an attempt to bring in the isolated teaching of *Minoda's* suspending the production of the sub-code into *Coverdale* would amount to improperly picking and choosing features from different references without regard to the

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<sup>2</sup> See outstanding Office Action at page 9, lines 1-4.

<sup>3</sup> See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

teachings of the references as a whole.<sup>4</sup> While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from somewhere within the record.<sup>5</sup> In this case, the record fails to support the proposed modification of Coverdale.

Applicants also respectfully traverse the Official Notes made by the pending Office Action in rejecting dependent Claims 13-15. It is established that "the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." See *In Re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Federal Circuit 2001); See 37 C.F.R. §1.104(d)(2) "[w]hen a rejection in an application is based on common knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant." Accordingly, Applicants herewith call for support of the Official Notes, or indication of allowability of dependent Claims 13-15.

The remaining independent Claims 4, 7, 12, 16 and 18 recite features that are similar or somewhat similar features as Claim 1. Accordingly, Applicants also traverse the rejections of these claims, and all rejections of the associated dependent claims.

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<sup>4</sup> See *In re Ehrreich* 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

<sup>5</sup> See *In re Lee*, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

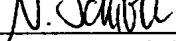
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicant's representative at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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